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Jiawei Huang
J.C. Patents
4 Venture, Suite 250
Irvine, CA 92618

In re Application of :
NAKANO et al. :
U.S. Application No. 09/856,402 :
PCT No.: PCT/JP00/07229 :
Int. Filing Date: 18 October 2000 :
Priority Date: 18 October 1999 :
Attorney Docket No.: EHAR0010 :
For: POLISHING MACHINE FOR :
PERIPHERAL EDGE OF :
SEMICONDUCTOR

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Petition Under 37 CFR 1.47(a)" filed 12 October 2001 to accept the application without the signatures of joint inventor, Hitoshi Tambo. The required petition fee of \$130.00 (37 CFR 1.17(i)) has been submitted.

BACKGROUND

On 18 October 2000, applicants filed international application PCT/JP00/07229 which claimed a priority date of 18 October 1999 and designated the United States. A Demand for international preliminary examination was not filed prior to the expiration of nineteen months from the international filing date. Accordingly, the twenty-month period for paying the basic national fee in the United States was midnight, 18 June 2001.

On 21 May 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which accompanied by, *inter alia*: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); the international application; and a preliminary amendment.

On 21 June 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 12 October 2001, applicant filed the present petition under 37 CFR 1.47(a) and a two-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR

1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1), (3) and (4) have been satisfied.

Regarding item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of its refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

A review of the present petition and the accompanying papers reveal that applicant has not satisfied item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims and drawings to Hitoshi Tambo. The mailing of the Declaration, Assignment, and Power of Attorney is not considered a complete copy of the application paper (specification, including claims, drawings, and oath and declaration). Additionally, Mineo Ishii states, "[t]he letter was delivered to Mr. Tambo on August 26, 2001" and has provided copies of the registered letter (Evidence 1) and delivery certificate (Evidence 2) to Mr. Tambo, however, these documents are in Japanese and have not been translated. Nor has Tambo's response (i.e. "Evidence 3") been translated. Applicant's must provide complete translations of Evidence 1, 2 and 3. Lastly, the declaration of Mineo Ishii states that, "Mr. Yushuhiro Kosawa succeeded in contacting with Mr. Tambo by telephone on September 5, 2001, and requested

his signature. In response, Mr. Tambo told Mr. Kozawa that he would not sign the documents." As stated above, "[w]here a refusal of the inventor to sign the application papers is alleged, the circumstances of its refusal must be specified in an affidavit or declaration by the person to whom the refusal was made." The statements regarding the refusal constitutes secondhand knowledge in that the refusal was made to Yashuhiro Kozawa, not Mineo Ishii.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Hitoshi Tambo under 37 CFR 1.47(a) at this time.

Additionally, the declaration is executed by Yasuhiro Kozawa, whereas the international application lists the inventor as Yasuhiro Kosawa. Clarification is required.(See MPEP 201.03, Page 200-5).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



Boris Milef
PCT Legal Examiner
PCT Legal Office



Anthony Smith
Attorney-Advisor
PCT Legal Office
Tel: 703-308-6314
Facsimile: 703-308-6459